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09/709,645	11/13/2000	Richard C. Fuisz	56915-021	3732

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,645

Applicant(s)

FUISZ ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 13, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 18 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to Applicant's request for continued examination and amendment filed on November 4, 2004. Claims 1-14 and 23-25 are presented for further examination. Claims 23-25 are new claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 14, the terms "second translation formula" and "said translation identifier" lack sufficient antecedent basis (i.e. there is no "first" translation formula mentioned and there is no "translation identifier" introduced). It appears that claim 14 should depend from claim 13, because claim 13 would provide sufficient antecedent basis for claim 14's terminology.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8, 10, 18, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Abir (U.S. Patent No. 6,738,827).

In considering claim 1, Abir discloses a method of generating from a computer ("client computer 1000") a request for a domain name, comprising the steps of:

Receiving on the computer a name ("alternative resource identifier" or "friendly resource identifier") associated with the domain name ("conventional resource identifier"), said received name having a top-level domain portion (i.e. Hebrew characters for "com") and a sub-domain portion (i.e. Hebrew characters for "www" or "healthinsurance," col. 3, lines 58-59; col. 4, lines 29-35; col. 5, lines 13-15, 24-25; col. 7, line 7);

Selecting a translation formula (col. 4, lines 22-33, 63-67; col. 6, lines 32-41, wherein the system uses either a "conversion algorithm" or a "mapping algorithm" depending on whether it recognizes part of the name to be a known word);

Translating said received name with said translation formula to generate a scheme-specific name by converting a sub-domain portion of said received name into a different sub-domain portion (see Figs. 2, 3, 14; col. 4, lines 29-33; col. 5, lines 13-15, 24-25, wherein the sub-domain portion "www" or "healthinsurance" is received in Hebrew and is converted to the English language equivalent); and

Generating, from the computer, a request for the domain name based upon said scheme-specific name (col. 7, lines 33-41, "the client computer would process the

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friendly resource locator using either the conversion algorithm or the mapping algorithm and would contact Web server for the appropriate HTML page”).

In considering claim 2, Abir further discloses receiving a translation identifier, and selecting said translation formula based at least in part on said received translation identifier (col. 6, lines 32-41, wherein the entered friendly resource locator itself will identify which translation, “conversion” or “mapping” will be used to translate the resource locator).

In considering claim 3, Abir further discloses that the translation identifier may comprise a geographical identifier (col. 8, line 25, “worldwide”; col. 1, line 59, “Israel”).

In considering claim 4, Abir further discloses analyzing the received name for a translation identifier (i.e. friendly resource locator itself will identify which translation formula to use, col. 6, lines 32-41).

In considering claim 5, Abir further discloses that the translation formula comprises at least one predetermined character and said step of translating the received name includes adding at least one said predetermined character to said sub-domain portion of said received name (i.e. the mapping formula “maps” Hebrew characters to Latin characters, and the received name is translated by adding the Latin

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characters to the sub-domain portion of the received name and deleting the Hebrew characters from the sub-domain portion).

In considering claim 6, Abir further discloses that the translation formula comprises a string of characters to add to said sub-domain portion of said received name (i.e. the conversion formula "converts" Hebrew words into English words, wherein it adds the English words to the sub-domain portion and deletes the Hebrew words).

In considering claim 7, Abir further discloses that translating the received name includes adding the string of characters to the received name as a prefix ("www" is a prefix of "healthinsurance").

In considering claim 8, Abir further discloses that the step of translating the received name includes the step of adding the string of characters to the received name as a suffix ("healthinsurance" is a suffix of "www").

In considering claim 10, Abir further discloses that the translation formula removes at least one character from the received name (i.e. the Hebrew characters are removed).

In considering claim 18, Abir discloses an apparatus for generating a request for a domain name, comprising:

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A computer comprising an input device (col. 7, line 4, "client computer 1000");

A browser operationally installed on said computer (col. 7, line 22, "browser");

A translation module configured to:

Receive, on the computer, a correctly formatted absolute uniform resource locator associated with the domain name from the input device (col. 8, lines 18-10; Fig. 14, wherein the full Hebrew dot-delineated version of the URL is received in the browser);

Select a translation formula (col. 4, lines 22-33, 63-67; col. 6, lines 32-41);

Translate said received URL with said translation formula to generate a scheme-specific name by converting a sub-domain portion of the received URL into a different sub-domain portion (the Hebrew word for "www" or "healthinsurance" is converted into the corresponding English word); and

Process the scheme-specific name through the browser to generate a request for the domain name (col. 7, lines 33-41, "the client computer would process the friendly resource locator using either the conversion algorithm or the mapping algorithm and would contact Web server for the appropriate HTML page").

In considering claim 23, Abir further discloses that the received name comprises a correctly formatted absolute URL (Fig. 14 shows the correctly formatted absolute URL in Hebrew).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abir, in view of www.1800flowers.com (Web Archives printout of the website www.1800flowers.com from 1996, hereinafter "1800Flowers").

In considering claim 11, although the system taught by Abir discloses substantial features of the claimed invention, it does not disclose that the translation formula converts said received name into a numeric entry. Abir instead remains silent regarding the use or potential use of numeric entries into the domain portions of the web address. Nonetheless, as evidenced by 1800Flowers, it is well known to include numeric entries as part of a Web address. A person familiar with both the Abir system and the 1800Flowers system would have readily recognized the desirability of allowing the Abir system to include numeric entries as part of the received name and thus as part of the translated name, because most languages, while using different alphabets, use the same number system. Thus, it would have been obvious to include numeric entries as part of the received and translated names taught by Abir.

In considering claim 9, in the combined system of Abir and 1800Flowers, the added string of characters (i.e. Latin characters corresponding to the entered Hebrew

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characters) would necessarily be interleaved with the numeric characters "1800" upon translating the domain name.

Allowable Subject Matter

4. Claims 12, 13, 24, and 25 are allowed.
5. Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

These claims are allowable for the reasons stated by Applicant in Applicant's remarks filed on November 4, 2004. See page 8, paragraph 2 of Applicant's remarks.

Response to Arguments

Applicant's arguments with respect to claims 1-11, 18, and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-

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3041. The examiner can normally be reached on Monday to Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bradley Edelman

BE

November 17, 2004